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| 3000 7590 02/19/2010 CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOV, LTD. 11TH FLOOR, SEVEN PENN CENTER 1635 MARKET STREET PHILADELPHIA, PA 19103-2212 | | | | |
| EXAMINER ALI, MOHAMMAD M | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@crbcp.com

Office Action Summary

Application No.

10/532,017

Applicant(s)

FUHR ET AL.

Examiner

MOHAMMAD M. ALI

Art Unit

3744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 21-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

Election/Restrictions

Claim 21-26 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 02/04/10.

Applicant's election with traverse of 02/04/10 in the reply filed on 10/05/09 is acknowledged. The traversal is on the ground(s) that the dependent claims further clarifying structures recited in the related independent claim is not cause of restriction. This is not found persuasive because the newly submitted claims 21-23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: as discussed earlier

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-23 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1--13, 15-19 and 20 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Smollett et al (3,292,424). Smollett et al disclose a cry storage device 22, and at least one data storage device 69 (The examiner considering relay as a data store device to store data when to operate the relay), and at least one sample receptacle device 77 with at least one sample chamber (the duct portion dipped in the oil sample 72) for the uptake of suspension sample, the at least one sample chamber 82 being connected to at least one data storage device 69 through fluid contained in the fluid chamber 15 and having elongated hollow shaped that extends from an inlet end located near the bottom 80 of the container 70 over a predetermined length to an outlet end having a wider diameter 99, wherein one sample chamber 82 is attached to the at least one data storage device 69 in a flexible (the conduit 82 being coiled is flexible and data storage device 69 is connected to 82 through fluid by a flexible electric cable 68 and movably and hanging manner. For claim 16 for mechanical separation see Fig.2 where conduit 84 has been mechanically separated from its continuity.

Regarding claims 1 and 12 the above disclosure of Smollett et al obviously disclose the limitations of claims 1 and 12.

Regarding claim 2, Smollett et al disclose that the at least one sample chamber (72/82 is a hollow cylinder, see Fig. 1) is a hollow cylinder, a hollow cone, a pipe, a tube, or a hollow needle.

Regarding claim 3, Smollett et al disclose that the at least one sample chamber (82) consists of a flexible, bendable material.

Regarding claim 4, Smollett et al disclose that the at least one sample chamber (72) is provided with at least one of a sensor (39), a temperature sensor, and cooling surfaces.

Regarding claim 5, Smollett et al disclose that the at least one data storage (69) device comprises at least one data storage with a housing, the housing being connected with the at least one sample receptacle (15/82) device.

Regarding claim 6 for multiplicity of data store is an obvious duplication of single data storage.

There is no patentable significance unless a new and unexpected result is produced. See MPEP 2144.03 (VI). Since it has been held that mere duplication of the essential working parts of a device involves only routine skill of art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

Regarding claim 7, Smollett et al disclose that a cross-sectional dimension of the at least one sample chamber (99) varies along a length of the at least one sample chamber, so that at least one sub-chamber with a cross-sectional dimension that is larger than cross-sectional dimensions of the inlet and outlet openings is provided. See Fig. 1.

Regarding claim 8, Smollett et al disclose that the at least one sample receptacle device (11) comprises a plurality of sample chambers (13, 15) connected with one another at their exterior walls, so that an integral, flexible sample chamber block is provided. See Fig. 1.

Regarding labeling for claim 9 is a known feature in the art would be obvious implementation with Smollett et al.

Regarding claim 10, Smollett et al disclose that an attachment device (66) is provided, with which the at least one sample chamber (15/82) is attached to the at least one data storage device (69) through the electric lead (68).

Regarding claim 11, Smollett et al disclose that the attachment device (66) comprises strips arranged individually or as a bundle, each of the strips having a first and a second end with a sample chamber (15) attached to the first end and the at least one data storage device (69) attached to the second end. into a low-temperature state by positioning at least a part of the cryostorage device in a cryo-medium.

Regarding claim 13, Smollett et al disclose that the uptaking comprises dipping the at least one sample chamber (99) with an inlet end in a sample reservoir and transferring of the suspension sample as a result of a reduced pressure

applied at a corresponding outlet end or of capillary forces. The inlet end of chamber (99) being narrower than the chamber (99), the pressure of samples after entering into the chamber (99) having wider space drops the pressure of the sample.

Regarding claim 15, Smollett et al disclose that at least one partial sample is detached from the at least one sample chamber (99/90) in the low-temperature state by mechanical separation (by pump 103).

Regarding claim 16, Smollett et al disclose that during the mechanical separation a local heating (local heating is being provided by bleed valve 107 by allowing comparatively high temperature bleed air which is not cooled by the cooling system of Smollett et al as shown in Fig. 1) of the respective sample chamber in a vicinity of the at least one partial sample that is to be separated or a separation at an attachment device between the respective sample chamber and the data storage device occurs. See Fig. 1.

Regarding claim 17 for sealing sample is also a known feature in the art and would be an obvious implementation with Smollett et al. However, at the metering pumps (86/103) are provided with some kind of sealing device or valve arrangement so that the pumps can meter according to the direction of a control device.

Regarding claims 18, 19 and 20, Smollett et al disclose to reduce up to 25 degree F as shown in column 2 of table of a test result. However, Smollett et al., do not disclose a reduced

temperature less than 100 degree C. It is known that a cryogenic apparatus is able to reduce temperature of an environment less than -100 degree C. Therefore, it would be an obvious choice of an ordinary skill to choose a reduced temperature of less than -100 degree temperature. It is also mentioned that creation of cryogenic temperature below 100 degree C is well known in the art. For evidentiary reference, see US Patent 4,739,622 to Smith, column 6, line 53.

In another way choosing a specific cooling value like less -100 C is simply discovering an optimum value of a result effective variable.

It is further mentioned that it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smollett et al., in view of Takiue (20020007256 A1). Smollett et al., disclose the invention substantially as claimed as stated above except measured data and reference data. Takiue teaches the use of a measured- data process center 32 comprises a data-storage 33, an analyzer 34. The data-storage

33 stores previously reference data in order to analyze the measured data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device and method of Smollett et al., in view of Takiue such that a data-storage capable of storing measured-data and reference data and analyze the measured-data with reference-data in order to obtain a desired analysis of the data.

Response to Arguments

Applicant's arguments filed 07/23/09 have been fully considered but they are not persuasive.

The Applicants argue that the thermal regulator switch 66 that is sensing the temperature of the chamber 15, is clearly not sensing the temperature of the duct cable 82 or of the sample 72.

The examiner disagrees. Above argument is contradictory because while sensing a temperature in a chamber containing the other element being cause of the temperature is not persuasive. The sensor which is capable to sense a temperature in chamber, the sensor is also capable to sense the temperature of any element in the chamber including the temperature of the duct 82.

The Applicants further argue that Smollett does not disclose a sample chamber being directly attached to the data storage device.

The Examiner disagrees. The chamber 15 is directly attached with duct 82 and the data storage chamber 69 is directly attached with chamber 15. Therefore, Smollett et al either anticipates or obviously teach that the data storage 69 is directly attached with chamber 15 or duct 82.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The Applicants further argue that Takiue does not teach at least one data memory chip adapted to store a plurality of data for claim 12 and 14.

The data memory chip is not the claimed subject matter of claims 12 and 14. It indicates from the above argument that the Applicants are arguing which not claiming.

Therefore, the rejections are ok. However, for allowing further scope the finality has been with drawn and a non-final has been forwarded to make the claims in allowable form.

The Applicant argued that Smollett does not disclose a cry storage device comprising at least one data storage device including at least one data storage adapted to store a plurality of data under cryo conditions. The examiner disagrees. First the claims do not disclose such disclosure and though no claims disclose such element, Smollett et al., disclose a cryo storage device 22 and one data storage device 69. The examiner considers that Smollett et al's data storage stores plurality of data because it works on plurality of switches 66 and 63. The applicant further argued that the components are not adapted for storing the sample under cryogenic conditions, for example, at very low temperature under -50 degree C. The examiner again disagrees. No claim under 102 rejections discloses such element. Therefore, the argument is not

valid for the 102 rejections. The container is sufficiently insulated to undergo a test requiring - 25 degree F which is equivalent to -30 degree C. As may be seen in the Table in column 6. Therefore, it is obvious that the container is sufficiently insulated that it could withstand at any less temperature including - 50 degree C. Therefore, the argument is not correct. Therefore, the rejections are ok.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD M. ALI whose telephone number is (571)272-4806. The examiner can normally be reached on maxiflex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl J. Tyler can be reached on 571-272-4808. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mohammad M Ali/
Primary Examiner, Art Unit 3744

